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DEC 3 1 2007

OFFICE OF PETITIONS

In re Application of	:	
Horai, et al.	:	
Application No. 10/693,314	:	ON PETITION
Filed: October 24, 2003	:	
Attorney Docket No. 890050.445	:	

This is a decision on the petition, filed October 22, 2007, under 37 CFR 1.183 to waive 37 CFR 1.131 to the extent that it requires that all of the named inventors execute the declaration filed thereunder.

The petition is **dismissed**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.183." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Petitioner asserts that all of the named inventors contributed to the conception of the claimed invention which is under rejection. However, only three of the four joint inventors, Horai, Fukuzawa, and Tsukamoto, have executed a declaration under 37 CFR 1.131 in support of establishing conception of the claimed invention prior to September 10, 2002.

Petitioner alleges that Inventor Hiroyuki Arioka cannot be located to sign the declaration under 37 CFR 1.131 and requests that the Office accept the previously filed joint declaration executed by less than all the joint inventors.

37 CFR 1.131(a) states,

When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

The Office has stated the signature requirements can be waived in certain circumstances.

- (1) The assignee or other party in interest can sign the affidavit or declaration if none of the inventors will sign the declaration. See MPEP 714.
- (2) The affidavit or declaration can be signed by fewer than all the inventors if the other inventors are deceased, refuse to sign, or are unavailable.

Petitioner has failed to prove the non-signing inventor, Hiroyuki Arioka, cannot be located to sign the declaration.

While this is not a petition under 37 CFR 1.47(a), it is evaluated much the same way a petition under 37 CFR 1.47(a) is. When it asserts that an inventor cannot be located to sign a declaration, a **showing of diligence** in attempting to locate him/her is required. The petition and supplemental declaration merely states that Mr. Arioka has resigned from TDK Corporation and cannot be located. What efforts were made to locate Mr. Arioka?

Petitioner should explain the efforts made to date to locate Mr. Arioka. Petitioner should probably engage in further efforts to locate Mr. Arioka. The following is a list of evidentiary sources that are commonly relied upon to prove inability to locate an inventor: searches of Internet databases; inquiries of local telephone directories; telegrams; and documented inquiries of last known employers. Every listed type of search need not be done. However, a diligent effort to find the inventor must be made.

Documentary evidence that supports a finding that the non-signing inventor could not be found or reached should be made part of any affidavits or declarations that fully describe the exact facts which are relied on to establish that a diligent effort was made to locate the non-signing inventor. Printed computer records would suffice.

The affidavit or declaration of facts must be signed, where at all possible, by a person having *firsthand knowledge* of the facts recited therein. Statements based on hearsay will not normally be accepted. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

If diligent search for Mr. Arioka results in his being located and he expressly refuses to sign a declaration under 37 CFR 1.131, then a statement from the person to whom that refusal was made should be made of record. If his refusal is in writing, the correspondence should be made of record.

Inquiries regarding this communication may be directed to the undersigned at (571) 272-3230.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3230.


Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions